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IBM CORP (YA)				
C/O YEE & ASSOCIATES PC				
P.O. BOX 802333				
DALLAS, TX 75380				
EXAMINER				
KHATTAR, RAJESH				
ART UNIT		PAPER NUMBER		
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10/07/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptonotifs@yeciipaw.com

Office Action Summary

Application No.

10/087,954

Applicant(s)

BANERJEE ET AL.

Examiner

RAJESH KHATTAR

Art Unit

3693

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 25-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-24 and 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

This office action is in response to Applicant's communication filed on 7/21/2008. Claims 1, 2, 4-9, 13, 23-24 have been amended. Claims 3 and 25-41 have been cancelled. New claim 42 has been added. As such, claims 1, 2, 4-9, 13, 23-24 and 42 are pending in the application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4-9, 23-24 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheets, US Patent Application No. 2001/0049653 in view of Flickinger et al., US Patent Application No. 2001/0025245 in view of Ibuki et al., US Patent Application No. 2003/0041058 in view of Geary, US Patent No. 6,070,160 in view of Wilson, US Patent No. 5,864,827 and further in view of Carothers et al., US Patent Application No. 2002/0069117.

Sheets discloses a computer implemented method for carrying out a bartering system over a network, the computer implemented method, comprising:

receiving a needs list having at least one needed item a user desires to acquire from a requesting computer system, by a first bartering system on a first computer system ([0025]-[0027]);

receiving a priority indication for the at least one needed item ([0026]), wherein the priority indication indicates a level of desire the user has in acquiring the at least one needed item ([0026]).

Sheets fails to specifically disclose

wherein the priority indication indicates items that are equivalent to the at least one needed item.

However, Flickinger discloses wherein the priority indication indicates items that are equivalent to the at least one needed item ([0070], [0073], search for comparable items).

Therefore, it would have been obvious to a person having ordinary skills in the art at the time the invention was made to modify the disclosure of Sheets to include the disclosure of Flickinger. The motivation for combining these references would have been to search for comparable or "better" items/prices as illustrated by Flickinger.

Both Sheets and Flickinger do not specifically disclose

receiving a specification of a range of near equivalency among non-identical barter items;

searching available items within the first bartering system using a first protocol language associated with the first bartering system,

responsive to finding a match in the available items for the at least one needed item, displaying match results to the user, wherein the match results comprises equivalent and near equivalent items matched with the at least one needed item based

on the priority indication for the at least one needed item and the specification of the range of near equivalency among non-identical barter items ([0060],

However, Ibuki discloses receiving a specification of a range of near equivalency among non-identical barter items ([0060]-[0087], plurality of similar values is presented to the user for selection);

searching available items within the first bartering system using a first protocol language associated with the first bartering system ([0077], [0079], [0087], claims 11-12, 33-34, 55-56),

responsive to finding a match in the available items for the at least one needed item, displaying match results to the user, wherein the match results comprises equivalent and near equivalent items matched with the at least one needed item based on the priority indication for the at least one needed item and the specification of the range of near equivalency among non-identical barter items ([0060]-[0087]).

Therefore, it would have been obvious to a person having ordinary skills in the art at the time the invention was made to modify the disclosure of Sheets and Flickinger to include the disclosure of Ibuki. The motivation for combining these references would be to present to the user an alternative value to be specified for an item in order to automatically widen the search criteria as illustrated by Ibuki.

Sheets, Flickinger and Ibuki fail to specifically disclose responsive to a failure to find a match in the available items with the at least one needed item within the first system on the first computer system, searching a second system on a second computer system over a network,

However, Geary discloses this limitation (col. 2, lines 50-col. 3, lines 3; col. 4, lines 40-col. 6, lines 45; col. 14, lines 64-col. 15, lines 12).

Therefore, it would have been obvious to a person having ordinary skills in the art at the time the invention was made to modify the disclosure of Sheets, Flickinger and Ibuki to include the disclosure of Geary. The motivation for combining these references would be to broaden the scope of the search as illustrated by Geary.

Sheets, Flickinger, Ibuki and Geary fail to specifically disclose wherein the second bartering system uses a second bartering protocol language that is different than the first protocol language, and wherein searching the second bartering system further comprises:

constructing a representation of the needs list in the first protocol language to a common representation of the needs list to form a barter protocol language representation of the needs list, wherein the bartering protocol language enables a bartering process to be compatible across multiple different bartering systems.

However, Wilson disclosing second protocol language that is different than the first protocol language and constructing a representation in the first protocol language to a common representation to form a protocol language representation, wherein the protocol language enables a process to be compatible across multiple different systems (col. 1, lines 5-col. 7, lines 55).

Therefore, it would have been obvious to a person having ordinary skills in the art at the time the invention was made to modify the disclosure of Sheets, Flickinger, Ibuki and Geary to include the disclosure of Wilson. The motivation for combining these

references would be to translate each transaction from FIX protocol into the proper protocol for the exchange to which it is to be transmitted (col. 6, lines 55-60).

Moreover, Sheets, Flickinger, Ibuki, Geary and Wilson fail to specifically disclose searching available items within the second bartering system using the barter protocol language representation of the needs list and responsive to a failure to find a match in the available items within the second bartering protocol system, searching available items in a third bartering system over the network using the barter protocol language representation of the needs list.

However, Carothers discloses this feature (Abstract, [0005]-[0015], [0050], [0053], [0063], [0069], [0084], [0086]-[0087], user make separate independent searches, often through multiple systems, multiple markets, plurality of market systems).

Thus, it would have been obvious to a person having ordinary skills in the art at the time the invention was made to modify the disclosure of Sheets, Flickinger, Ibuki, Geary and Wilson to include the disclosure of Carothers. The motivation for combining these references would be to communicate the query directly to at least one of a plurality of market systems as illustrated by Carothers.

Regarding claim 2, Ibuki discloses the bartering protocol language specifies the range of near equivalency associated with a plurality of dissimilar items to form near equivalent items, wherein the near equivalent items are items that are dissimilar to the at least one needed item, and wherein the priority indication indicates whether a near equivalent item will be satisfactory to the user in lieu of the at least one needed item

([0079], plurality of similar values represent near equivalent items that are dissimilar to the needed item since the exact match is not found).

Regarding claim 4, Carothers discloses receiving an availability list from the user ([0053]), wherein the availability list specifies items the user is willing to make available to others for barter ([0009], [0053]);

searching needs lists of others to determine if an item on another needs list matches an item on the availability list from the user (Abstract, [0050], [0053]).

Wilson discloses

constructing a barter protocol language representation of the availability list (col. 1, lines 5-col. 7, lines 55).

Regarding claim 5, Ibuki discloses wherein the needs list further comprises an associated priority indication indicating a user's desire to accept a given near equivalent item in lieu of a given needed item if a match for the given needed item is not found ([0060]-[0087]).

Regarding claim 6, Geary discloses the match is a direct match having a one to one correspondence (col. 8, lines 5-15, col. 18, lines 2-15).

Regarding claim 7, Ibuki discloses a match in the match results is a chained association involving the needs list and availability lists of a plurality of users ([0057]-[0063]).

Regarding claim 8, Wilson discloses translating, before the searching is performed across the different bartering system, the needs list from the first protocol

language to the second protocol language to form the barter protocol language (col. 1, lines 5-col. 7, lines 55).

Regarding claim 9, Ibuki discloses a second priority indication for a given available item on the availability list from the user indicating a desire of the user to use the given available item to carry out a bartering transaction ([0079]).

Regarding claim 23, Ibuki discloses indicating equivalency of at least one available item with at least one needed item ([0079]).

Regarding claim 24, Ibuki discloses finding a match for at least one given available item in consideration for a found match for at least one given needed item, wherein the at least one available item, and the at least one needed item are represented in terms of equivalency ([0079]).

Claim 42 is substantially similar to claims 1-2, 4-9, 23-24 and hence rejected on similar grounds.

Claims 10-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheets in view of Flickinger in view of Ibuki in view of Geary in view of Wilson in view of Carothers and further in view of Official Notice. Sheets, Flickinger, Ibuki, Geary, Wilson and Carothers disclose their invention as described above. All fail to specifically disclose the second priority indication is indicated by a monetary value that the user is willing to accept for the given available item, receiving a monetary value associated with each of the at least one needed item, receiving a monetary value priority indication, associated with the received monetary value, wherein the monetary value priority indication indicates a user's willingness to vary a payment value for a given needed item

from the monetary value, receiving monetary value associated with each of the at least one available item, receiving monetary value priority indication, associated with the received monetary value, wherein the monetary value priority indication indicates a user's willingness to vary a received value for a given available item from the monetary value, the monetary value is received from data provided by a rating agency, receiving a priority indication for a group of two or more items, the barter protocol language is XML, one needed/available item can be at least one of a physical item and a nonphysical item, each physical and nonphysical item has a corresponding representation mechanism within the barter protocol language, the nonphysical item represents a needed/available service. Examiner takes Official Notice as these limitations e.g. the second priority indication is indicated by a monetary value that the user is willing to accept for the given available item, receiving a monetary value associated with each of the at least one needed item, receiving a monetary value priority indication, associated with the received monetary value, wherein the monetary value priority indication indicates a user's willingness to vary a payment value for a given needed item from the monetary value, receiving monetary value associated with each of the at least one available item, receiving monetary value priority indication, associated with the received monetary value, wherein the monetary value priority indication indicates a user's willingness to vary a received value for a given available item from the monetary value, the monetary value is received from data provided by a rating agency, the barter protocol language is one of a markup language e.g. XML, one needed/available item can be at least one of a physical item and a nonphysical item, each physical and

nonphysical item has a corresponding representation mechanism within the barter protocol language, the nonphysical item represents a needed/available service are old and well known in the art.

Therefore, it would have been obvious to a person having ordinary skills in the art at the time the invention was made to modify the disclosure of Sheets, Flickinger, Ibuki, Geary, Wilson and Carothers to include the limitations that are old and well known as per Official Notice. The motivation for combining these references would have been within the knowledge of a person skilled in the art.

As per MPEP § 2144.03(C), with respect to an Examiner's use of Official Notice:

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111 (b).

The same section continues:

If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate.

Applicant has not challenged or traversed the examiner's use of official notice in the previous office action, and repeated herein. This being the case, the examiner now considers as admitted prior art, the use of the second priority indication is indicated by a monetary value that the user is willing to accept for the given available item, receiving a monetary value associated with each of the at least one needed item, receiving a monetary value priority indication, associated with the received monetary value, wherein the monetary value priority indication indicates a user's willingness to vary a payment

value for a given needed item from the monetary value, receiving monetary value associated with each of the at least one available item, receiving monetary value priority indication, associated with the received monetary value, wherein the monetary value priority indication indicates a user's willingness to vary a received value for a given available item from the monetary value, the monetary value is received from data provided by a rating agency, the barter protocol language is one of a markup language e.g. XML, one needed/available item can be at least one of a physical item and a nonphysical item, each physical and nonphysical item has a corresponding representation mechanism within the barter protocol language, the nonphysical item represents a needed/available service.

Response to Arguments

With respect to 35 U.S.C. 101 rejection of claims 1-24, Examiner withdraws the rejection as Applicant's amendment addressed the issue.

With respect to 35 U.S.C. 112, second paragraph, rejection of claims 1-41, Examiner withdraws the rejection in view of Applicant's amendment.

Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAJESH KHATTAR whose telephone number is (571)272-7981. The examiner can normally be reached on Flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/
Supervisory Patent Examiner, Art Unit 3693

/R. K./
Examiner, Art Unit 3693